REMARKS/ARGUMENTS

Prior to entry of this amendment, the application included claims 1-34. An Office Action mailed August 10, 2005, rejected claims 1-4, 6-9, 11-15, 17, 19, 23 and 26 under 35 U.S.C. § 103(a) as being unpatentable over US Publication No. 2002/0194116 to Coakley ("Coakley") in view of US Patent No. 6,009,459 to Belfiore et al. ("Belfiore"). Claims 5, 10, 16, 18, 20-22, 24, 25 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Coakley in view of Belfiore and further in view of US Patent No. 6,422,523 to Siegel ("Siegel"). Claims 23-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Coakley in view of Belfiore and further in view of Siegel and US Patent No. 5,881,131 to Farris et al. ("Farris"). Claim 34 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Coakley in view of US Publication No. 2004/0019535 to Perkowski ("Perkowski") and US Publication No. 2002/0147724 to Fries et al. ("Fries"). Claim 1 was objected to for an informality.

This amendment amends claims 1 and 5 but does not add or cancel any claims. Hence, after entry of this amendment, claims 1-34 remain pending for examination.

Claim Amendments

Claims 1 and 5 have been amended to correct mistakes in punctuation. It is submitted that these amendments neither add any new matter nor change the scope of claims 1 and 5 in any respect.

Objection To Claim 1

Claim 1 was objected to for an informality. Claim 1 has been amended as noted above, and it is believed that the amendment to claim 1 overcomes the objection to that claim.

§ 103 Rejections

All pending claims were rejected under § 103(a) as unpatentable over Coakley, in combination with a variety of references. These rejections are respectfully traversed, for at least the reasons discussed below, and reconsideration of the rejected claims is respectfully requested.

Independent claims 1, 6 and 12 were rejected as unpatentable over the combination of Coakley and Bellfiore. These rejections are respectfully traversed, at least because the cited combination of Coakley and Bellfiore fails to teach or suggest each element of any of these claims, and because (as discussed below), the Office Action has shown no motivation or suggestion to combine Coakley and Bellfiore.

Take, for example, claim 1, which recites, inter alia, "receiving a URL address of the Web page on the Internet to be searched," "accessing and searching contents of the Web page of the URL address received for matches in the contents of the Web page corresponding to the search string, wherein the searched contents includes elements other than only a domain name," and "determining an unauthorized used of the at least one trademark, tradename, celebrity name, and/or famous name." Neither Coakley nor Bellfiore teaches or suggests these elements of claim 1.

Coakley is directed to a "Computer Implemented Trademark Brokerage Network," which

> facilitate[s] the brokering of trademarks between trademark owners and potential trademark buyers. The system stores trademarks of potential sellers and obtains identification descriptions associated with each of the trademarks. A trademark brokerage database is then populated with these trademarks and with the descriptions. The trademarks in the trademark brokerage database are made available through a network for acquisition by potential buyers. The system provides access to the trademark brokerage database through suitable browser interfaces, allowing potential trademark buyers to enter queries related to the trademark subject matter that interests them. The database is configured so that trademarks are associated with information reflective of the registered subject matter (e.g., description of goods and services and/or international trademark classification). This allows the potential buyer to identify offered marks that fit the potential buyer's trademark needs. The system generates query results based on the user's query and presents those results to the potential buyers via the browser interface.

Coakley, ¶ 0005. Hence, Coakley is directed towards a system of brokering transactions between trademark buyers and sellers, and the system provides a searchable database from which prospective buyers can search for trademarks that they might be interested in purchasing.

Nowhere does Coakley teach or suggest that its system might "determine an unauthorized use of . . . at least one trademark . . . ," as recited by claim 1. Indeed, since Coakley's system is directed towards providing a database of trademarks available for sale, the database of Coakley could not be used to determine an unauthorized use of a trademark, since an unauthorized user of a trademark would not be the owner of such a mark and, therefore, would not be able to sell the mark to an interested buyer.

The Office Action asserts that paragraphs 0016-0018 teach "receiving a URL address of the Web page on the Internet to be searched," "accessing and searching contents of the Web page of the URL address received for matches in the contents of the Web page corresponding to the search string, wherein the searched contents includes elements other than only a domain name," and "determining an unauthorized used of the at least one trademark, tradename, celebrity name, and/or famous name." The Applicants respectfully submit that no reasonable interpretation of Coakley supports this inference. Instead, paragraph 0016 of Coakley teaches that the "trademark brokerage engine determines whether any trademarks within trademark brokerage database 32 satisfy a search request" (emphasis added). That is, paragraph 0016 teaches searching a proprietary database for a particular trademark, not receiving a URL address of a web page on the Internet to be searched nor accessing and searching contents of the web page, as recited by claim 1.

Similarly, paragraphs 0017 and 0018 of Coakley teach that other proprietary databases (such as Dialog and Thomson and Thomson) might be searched in addition to the database provided by Coakley's system. This additional disclosure, however, still fails to teach the elements of claim 1 quoted above. In particular, Coakley never teaches or suggests receiving a URL of a web page to be searched. Coakley also never teaches or suggests searching a web page (as opposed to a trademark database).

In particular, Coakley never teaches or suggests determining an unauthorized use of a trademark. Coakley merely teaches searching a database of owned trademarks. If these trademarks are "owned" by the owners listed in Coakley's database, they per se cannot be unauthorized uses. Coakley is directed to a system of brokering legitimate trademarks, not

policing the unauthorized use of such trademarks. Hence, it is difficult to see how Coakley could be used to determine an unauthorized use of a trademark.

As noted above, Coakley fails to teach or suggest multiple elements recited by claim 1. Bellfiore does not provide the disclosure missing from Coakley. Bellfiore is directed to a system for Internet searching, whereby "[s]earches are automatically initiated to intelligently locate resources, particularly World Wide Web sites, within a distributed environment in response to a user specifying text via a user interface element." Bellfiore, Abstract. Bellfiore does not teach or suggest the elements of claim 1 discussed above.

Accordingly, the combination of Coakley and Bellfiore fails to teach or suggest each element of claim 1, and claim 1 is believed to be allowable over the cited references. Reconsideration of claim 1 in light of these arguments is respectfully requested. Independent claims 6 and 12, which are directed to a system and software program, respectively, recite elements similar to those discussed above with respect to claim 1, and those claims are believed to be allowable for at least similar reasons.

Independent claims 5, 10 and 16 were rejected under § 103(a) as unpatentable over the combination of Coakley and Bellfiore, in view of Siegel. These rejections are traversed as well, at least because the combination of Coakley, Bellfiore and Siegel fails to teach or suggest each element of any of these claims, and because the Office Action has identified no permissible motivation or suggestion to combine Coakley and Bellfiore, let alone Siegel.

For example, claims 5, 10 and 16, which are directed, respectively, to a method, a system and a software product, each recite elements similar to those discussed above with respect to claim 1. Siegel fails to remedy the failings of Coakley and Bellfiore describe above, and claims 5, 10 and 16 are believed to be allowable for at least reasons similar to those discussed above.

In addition, claim 5 recites, inter alia, "obtaining information relating to an owner of the URL address conducting the unauthorized use." The Office Action appears not to address this element of claim 5, and a review of Coakley, Bellfiore and Siegel reveals no teaching or

suggestion in any of the references for this element. Claim 5 also recites "informing the owner of the unauthorized use." The Office Action asserts that paragraphs 0006 and 0021 of Coakley teach this element. The Applicants respectfully disagree. First of all, since Coakley never determines an unauthorized use of a trademark, it is difficult to see how Coakley might inform an owner of such an unauthorized use.

Moreover, paragraphs 0006 and 0021 do not disclose "informing the owner [of the URL address conducting the unauthorized use] of the unauthorized use." Paragraph 0006 teaches only that "a broker acts as intermediary, putting buyer and seller in contact with one another using information stored in the database regarding identity of trademark owner (seller) and buyer." This disclosure merely teaches that Coakley's system might be used to arrange a contact between a seller of a trademark and a potential buyer. This does not teach or suggest informing the owner of a URL of an unauthorized use of a trademark.

Nor does paragraph 0021 of Coakley teach or suggest this element. Paragraph 0021 merely teaches that Coakley's system might determine which international trademarks are up for renewal (see Coakley, ¶ 0019) and that such a determination might provide an indication of trademarks which are more likely to be able to be purchased "due to trademark owners being more likely to sell their trademarks when fees are due in order to maintain the trademarks." This paragraph does not teach or suggest informing an owner of a URL address of an unauthorized use.

For at least these additional reasons, claim 5 is believed to be allowable over the combination of Coakley, Bellfiore and Siegel. Claims 10 and 16 are believed to be allowable for at least such reasons as well, and reconsideration of claims 5, 10 and 16 is respectfully requested.

Claim 34 was rejected under § 103(a) as unpatentable over the combination of Coakley, Perkowski and Fries. This rejection is respectfully traversed as well, at least because the cited combination fails to teach or suggest each element of claim 34 and because there would be no motivation or suggestion to combine the cited references.

For example, claim 34 recites "forming a search string based on the search term" and "storing the search string in a first database." The Office Action asserts that paragraphs 0016, 0017 and 0044 teach these elements. A review of these portions of Coakley reveals no teaching or suggestion of these elements. For instance, paragraph 0016 of Coakley indicates that "trademark brokerage engine 36 determines whether any trademarks within trademark database 32 satisfy such a search request." This does not teach or suggest forming a search string based on a search term; if anything, it indicates that the system of Coakley uses the search request provided by the user (in its original form) to search the database, not that it creates a new search string from a provided search term.

Moreover, nothing in paragraphs 0016, 0017 or 0044 (or anything else in Coakley, for that matter), teaches or suggests storing a search string in a database. Paragraph 0016 does teach that "a potential buyer can . . . express an interest in one or more of the trademarks automatically through a web page or through electronic mail which activity is then recorded in trademark database 32." Recording this expression of interest in a particular mark does not teach or suggest that a search string formed from a provided search term might be stored in a database, however.

Claim 34 also recites "queuing the search string for a scheduled search" and "performing a scheduled search with at least one search engine to produce a search result comprising at least one uniform resource locator ('URL')." Assuming that Coakley did teach forming a search string (which it does not), Coakley does not teach queuing the search string for a scheduled search. While Coakley does teach, as noted above, that additional proprietary databases might be searched, *see* Coakley ¶ 0018, this disclosure does not teach or suggest queuing a search string for a scheduled search, and it certainly does not suggest performing a scheduled search.

Nor does Coakley teach "identifying an owner of a domain associated with at least one web page." Paragraph 0005 of Coakley does disclose that "[t]he system stores trademarks of potential sellers and obtains identification descriptions associated with each of the trademarks. A trademark brokerage database is then populated with these trademarks and with

the descriptions." Even assuming that Coakley also stores an identification of each such trademark, this does not teach or suggest identifying an owner of a domain associated with at least one web page, as recited by claim 34. As noted above with respect to claim 1, Coakley also fails to teach or suggest "determining whether the at least one web page constitutes an unauthorized use of the search term," which is recited by claim 34.

Hence, Coakley fails to teach or suggest multiple elements of claim 34. Neither Perkowski nor Fries supply these missing elements. Moreover, there is no motivation or suggestion to combine Coakley with Perkowski and Fries. Perkowski is directed to a system "for delivering consumer product related information to consumers within retail environments using Internet-based servers and sales agents." Perkowski, ¶ 0002. Nothing in Perkowski teaches or suggests, for example, queuing a search string for a scheduled search, performing a scheduled search with at least one search engine to produce a search result comprising at least one URL, or determining an unauthorized use of a search term. Nor does Fries teach these elements. Accordingly, claim 34 is believed to be allowable over the combination of Coakley, Perkowski and Fries, and reconsideration of that claim is respectfully requested.

Moreover, there is no teaching or suggestion to combine Coakley with either Bellfiore, Fries or Perkowski. Nothing in Coakley teaches or suggests the concept of searching the Internet for trademarks. Instead, Coakley limits its searching to established trademark databases, for a good reason. Coakley is directed to a system for searching trademarks available for purchase, and for that purpose the system limits its searching to databases of available trademarks. It is difficult to see how searching the Internet for a mark might provide any indication that the mark is available for sale. Hence, all of the Internet searching and crawling features provided by Fries, Perkowski and Bellfiore would be of no use in the system of Coakley, and none of those references provide any additional teaching or suggestion that they might be implemented in a trademark brokerage system or, for that matter, in any system that uses established databases to store lists of trademarks available for sale.

For instance, the Office Action suggests that one skilled in the art would be motivated to combine Perkowski with Coakley "for performing the search in order to produce a

search result including URL." Nothing in Coakley indicates any need for a search to produce a search result including a URL. Since Coakley is directed only to searching databases (for which a URL is not needed), the additional teaching of Perkowski adds no benefit to the system of Coakley. Indeed, since the system of Coakley does not search the Internet at all, it is hard to see how a search result including URLs could even be implemented within Coakley's system with any reasonable expectation of success. Similarly, Fries's system of crawling web pages would add no benefit to the system of Coakley.

The Office Action asserts, as a motivation for the combination of Coakley with Bellfiore, Perkowski and Fries, "enforcing the trademark rights within the whole Internet" and "to enforce trademark rights within the whole Internet." Office Action, p. 7, l. 23. Neither Coakley, Perkowski nor Fries even mentions the enforcement of trademark rights, and none of those references provide any teaching or suggestion that it would be beneficial to enforce trademark rights within the whole Internet. Coakley is directed towards a system of brokering (not enforcing) trademark rights, and neither Bellfiore, Perkowski and Fries even mentions trademark rights at all.

The Office Action's proposed motivation to combine the references, therefore, clearly is taken from the disclosure of the present application (*see* Application, p. 1, ll. 10-13). ("The present invention provides a process and an apparatus for . . . comprehensively searching the Internet for potentially infringing uses of trademarks in domain names and other Web page content . . .") This type of hindsight reasoning cannot form the basis of a prima facie case of obviousness under § 103(a). *See* MPEP § 2143 ("the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure."). Hence, even if the combinations cited by the Office Action did teach any element of any pending claim (which, as noted above, they do not), there has been identified no suggestion or motivation to combine the references in the contemplated manner, and independent claims 1, 5, 6, 10, 12, 16 and 34 are believed to be allowable for at least this additional reason.

For at least the reasons stated above, independent claims 1, 5, 6, 10, 12, 16 and 34 are allowable over the cited references. Dependent claims 2-4, 7-9, 11, 13-15 and 17-33 are believed to be allowable, at least because they each ultimately depend from allowable base claims. The Applicants, therefore, respectfully request the reconsideration of all pending claims in light of the arguments herein.

Conclusion

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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